REMARKS

The Official Action dated March 3, 2003 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 127-172 have been cancelled and claims 173-176 have been added. Support for the presently claimed invention may be found at page 6, line 8 to page 9, line 24; page 15, lines 8-18; and page 16, lines 1-20. Since these changes do not involve any introduction of new matter and do not raise any new issues after final rejection, entry is believed to be in order and is respectfully requested.

Applicants appreciate the Examiner granting and conducting a personal interview on April 9th, 2003 during which Applicants discussed the presently claimed invention and the cited prior art. As discussed during the personal interview, Applicants have amended the claims to overcome the cited prior art and have clearly defined non-linking functionality in the claims. The Examiner indicated that he would consider the amendment and perform an updated search. The Examiner also asked Applicants to describe how their presently claimed invention is different from copying a link received in an email and subsequently pasting the link into a browser. In addition, the Examiner asked Applicants to describe how the presently claimed invention is different from the standard internet shopping cart model.

THE CLAIMED INVENTION DIFFERS SIGNIFICANTLY FROM A TYPICAL CUT AND PASTE OPERATION

The presently claimed invention visually generates a plurality of individually selectable user options in response to the designation of a hyperlink and allows a user to automatically copy the selected hyperlink to the second window in response to a selection. The complete hyperlink, including the name and any associated graphical element is

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automatically copied to a new window that is capable of allowing a link to be posted. This automatic action in response to a single selection is in sharp contrast with the multiple actions that would be required in a typical multi-step "cut and paste" operation involving a hyperlink. In order to generate the same results using typical cut and paste operation, one would first have to copy the hyperlink into the memory of the computer, then manually open a new window, then manually edit/generate corresponding HTML code and manually paste the hyperlink into the HTML code and then manually add the title of the hyperlink in the HTML code. In addition, if a user does a traditional cut and paste on a hyperlink, the only thing copied is the actual link (i.e., http://www.dinslaw.com) and not the title associated with the hyperlink that appears in the browser window (i.e., "Dinsmore & Shohl LLP"). In contrast, the present invention automatically copies the actual name of the hyperlink, the underlying HTML link, and any graphical element associated with the hyperlink, which allows easy reference by a user at a later time reviews the list of copied hyperlinks.

THE CLAIMED INVENTION ALSO DIFFERS SIGNIFICANTLY FROM A TYPICAL ELECTRONIC COMMERCE SHOPPING CART

The claimed invention also substantially differs from a typical shopping cart. A typical shopping cart model on an internet e-commerce website is a specific HTML function that requires additional database programs and active webpage development. In addition, the shopping cart only works on the website that a user is visiting. For example, if a user is on Amazon.com and adds an item to his shopping cart at that web site, and thereafter visits his shopping cart at another web site, as for example,Walmart.com, the items placed in the shopping cart at Amazon.com will not appear at the Walmart.com site. The shopping cart is a webpage contained on the web server of the e-commerce website, whereas the presently claim invention creates a list of hyperlinks that are automatically copied to a second window and are stored locally on the user's computer. This allows the user to copy hyperlinks from a

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vast variety of web sites into the second window to be later visited. In addition, the present invention also captures any associated graphical element, such as a picture, into the second window. The traditional shopping cart model does not copy the hyperlink, but rather takes an inventory item from a database (e.g., Cold Fusion or Microsoft SQL server) and generates a webpage with items from the database matching your user account, but there is no hyperlink copying in the shopping cart model. The user cannot later visit these links without first logging into the webpage for the corresponding e-commerce shopping cart. The present invention automatically copies the selected hyperlink into another window for later visiting, and allows the user to visit multiple distinct websites.

THE INFORMALITIES REFERENCED IN THE PRIOR OFFICE ACTION HAVE BEEN ELIMINATED

In the Official Action, claims 137 and 155 were objected to for informalities. Claims 137 and 155 have been cancelled, whereby the objection has been overcome. Reconsideration is thus respectfully requested.

THE CLAIMED INVENTION PATENTABLY DISTINGUISHES OVER THE PRIOR ART RELIED UPON BY THE EXAMINER IN THE PRIOR OFFICE ACTION

In the Official Action, claims 127-129 and 151-153 were rejected under 35 U.S.C. § 102(e) as being anticipated by Gennaro et al. (U.S. Patent No. 5,742,768). The Examiner asserted that Gennaro et al. teach a method of operating a computer comprising providing a visual display, displaying digital content in a first window on the visual display, the digital content including a hyperlink, wherein the hyperlink comprises computer program code, providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink, and visually generating a plurality of user selectable options on the visual display in response to the designation of the hyperlink, wherein the user selectable

options comprise at least one option with non-linking functionality. The Examiner further asserted that Gennaro et al. teach the generation of the user selectable options on the visual display in response to the designation of the hyperlink does not require modification to the computer program code corresponding to the designated hyperlink and wherein the functionality of the user selectable options does not require modification to the computer program code corresponding to the designated hyperlink.

However, as will be set forth in detail below, it is submitted that the methods of operating a computer defined by claims 173-176 are not anticipated by Gennaro et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 173, the present invention is directed to a method of operating a computer. The method comprises providing a visual display; displaying digital content in a first window on the visual display, the digital content including a hyperlink; providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink; visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically copying the hyperlink to a second window in a manner that permits the copied hyperlink to be independently activated and processed; and selecting the individually selectable user option of copying the hyperlink to a second window and automatically performing such non-linking functionality of automatically copying the hyperlink to a second window in response to the selection.

As defined by claim 176, the present invention is directed to a method of operating a computer. The method comprises: providing a visual display; displaying digital content in a first window on the visual display, the digital content including a hyperlink; providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink; visually generating a plurality of individually selectable user options on the visual

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display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in a second window, and loading the digital content associated with the designated hyperlink in the first window on the visual display; and selecting the individually selectable user option of automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in a second window, and loading the digital content associated with the designated hyperlink in the first window on the visual display and performing such non-linking functionality in response to the selection.

The Claimed Invention Is Not Disclosed In The Gennaro et al. Reference

The Gennaro et al. reference discloses a method for providing a web page having an embedded hyperlink menu to a web browser and for displaying the web page to a user of the web browser. When a user moves a pointer over a hyperlink, a drop down menu with additional related hyperlinks is displayed. The user may select the original hyperlink or one of the additional hyperlinks in the drop down menu. Despite displaying additional hyperlinks, the user either clicks on and follows a particular hyperlink or ignores the hyperlink. The user selectable options displayed in the drop down menu as disclosed by the Gennaro et al. reference <u>consist only of linking functionality options</u> (i.e. open the webpage corresponding to the hyperlink. There is no suggestion in Gennaro et al of associating a hyperlink with any type of non-linking functionality, much less the specific non-linking functionality defined in the amended claims of the present application.

Applicants find no disclosure or suggestion in the Gennaro et al. reference of a plurality of individually selectable user options corresponding to the designated hyperlink, wherein at least one of the options includes non-linking functionality. In the Official Action,

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the Examiner asserted that the Abstract, Figs 2A-2B and Col. 4, lines 1-59 of the Gennaro et al. reference disclose at least one user selectable option with non-linking functionality. However, the Examiner's attention is directed to Col. 4, lines 37-41 which discloses that the embedded menus include a number of links having linking functionality, wherein each link provides a link to another web page or resource.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 808 F.2d 1490, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). Gennaro et al. only disclose user selectable options which are additional links to another web page or resource and therefore the user selectable options disclosed by Gennaro et al. consist only of linking functionality. As Applicants find no teaching or disclosure by Gennaro et al. of a plurality of individually selectable user options including at least one option with non-linking functionality such as automatically copying a hyperlink to a second window or automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in a second window, and loading the digital content associated with the designated hyperlink in the first window on the visual display., Gennaro et al. do not anticipate claims 173-176 under 35 U.S.C. §102.

It is therefore submitted that the presently claimed methods of operating a computer are not anticipated by Gennaro et al., whereby the rejection under 35 U.S.C. §102(e) has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 130-150 and 154-172 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gennaro et al. in view of Himmel et al. (U.S. Patent No. 6,211,874). The Examiner noted that the Gennaro et al. reference does not teach upon user selection of one of the user selectable options copying the hyperlink and any associated graphical elements to a viewable list in a second window. The Examiner asserted that

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Himmel et al. disclose copying the hyperlink to a viewable list in a second window. The Examiner asserted it would have been obvious to copy a hyperlink to a new window because it would enable the user to conveniently designate a URL for multiple-link processing for accessing even when the hyperlink is not present in the displayed page.

However, as will be set forth in detail below, it is submitted that the methods of operating a computer and computer program code products of claims 173-176 are non-obvious and patentably distinguishable from the teachings of Gennaro et al. in view of Himmel et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

The deficiencies of Gennaro et al. are noted above. Specifically, Gennaro et al. fail to teach or suggest a method of operating a computer, wherein the plurality of individually selectable user options including at least one option with non-linking functionality such as automatically copying a hyperlink to a second window or automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in a second window, and loading the digital content associated with the designated hyperlink in the first window on the visual display.

The Himmel et al. Reference Does Not Overcome The Deficiencies Of Gennaro et al.

Himmel et al. does not overcome these deficiencies of the Gennaro et al reference. Himmel et al. disclose a method of accessing files located in a computer system, by selecting a plurality of embedded links from one or more pages displayed in a browser window and processing the plurality of embedded links concurrently.

Applicants find no teaching or suggestion by Himmel et al. of visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, wherein the individually selectable user options include at least one option with non-linking functionality. In addition, Applicants find no teaching or

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suggestion by Himmel et al. for copying the hyperlink including any associated graphical elements to a second window on the visual display upon user selection of one of the user selectable options, wherein each hyperlink in the second window is independently able to be activated and processed. Himmel et al. disclose a method of concurrently processing every hyperlink in the viewable list in the second window, whereas the present invention requires the hyperlink to be capable of being independently activated and processed rather than concurrently processed with other hyperlinks in the viewable list as disclosed by Himmel et al.

There Is No Teaching Or Suggestion For The Combination Of Gennaro et al. And Himmel et al. References

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support the use in the particular claimed combination, as in the present invention, *Smith-Klein Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination, *In re Grabiak*, 222 U.S.P.Q. 2d 870, 872 (Fed. Cir. 1985). Applicants find no teaching or suggestion for the combination of Gennaro et al. and Himmel et al. Himmel et al. disclose a method of **concurrently** processing hyperlinks from web pages. The concurrent processing of web pages allows a user to open multiple web browser windows at the same time for a list of hyperlinks, or to print the content associated with a list of multiple hyperlinks. Gennaro et al. disclose a method of displaying an

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embedded menu to allow a user to select and process a single hyperlink **individually** from other hyperlinks on the embedded menu of the web page.

There must be some teaching, suggestion or motivation in the prior art to combine the references in the manner suggested by the Examiner. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). Furthermore, obviousness cannot be limited to a discussion of the ways multiple prior art references can be combined to read on the invention; rather, obviousness requires a suggestion, teaching or motivation to combine prior art references cited against pending claims, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The Examiner must show reasons why those skilled in the art, confronted with the same problems as an Examiner and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed, *In re Rouffet*, *supra*. The Examiner asserted the motivation for combining Gennaro et al. with Himmel et al. as enabling a user to conveniently designate a URL for **multiple-link processing** for accessing even when the hyperlink is not present in the displayed web page. However, the present invention does not comprise multiple-link processing. The claims of the present invention require each hyperlink in the viewable list in the second window to be independently able to be activated and processed. As such, Applicants find no teaching or suggestion for the combination of Gennaro et al. and Himmel et al.

Even If Combined, The Combination Of The Gennaro et al. And Himmel et al. Referencess Fail To Meet The Claimed Invention

Moreover, references relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (C.C.P.A. 1979). Applicants find no teaching by Gennaro et al. or Himmel et al., alone or in combination, of a method of using a computer comprising automatically copying a hyperlink including any associated graphical elements to

a second window on the visual display upon user selection of one of the individually

selectable user options, wherein each hyperlink in the second window is independently able

to be activated and processed.

Furthermore, to establish prima facie obviousness of the claimed invention, all the

claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180

U.S.P.Q. 580 (C.C.P.A. 1974). In view of the failure of Gennaro et al. or Himmel et al, alone

or in combination, to teach, disclose or suggest a method of using a computer comprising

automatically copying a hyperlink and any associated graphical elements to a second window

on the visual display upon user selection of one of the individually selectable user options,

wherein each hyperlink in the second window is independently able to be activated and

processed, Gennaro et al. and Himmel et al. do not render the presently claimed methods of

operating a computer. The methods of the present invention allow a user to select a hyperlink

and its associated graphical elements to be placed in a list in a second window, wherein each

hyperlink placed in the second window can be individually activated and processed. It is

therefore submitted that the presently claimed methods are non-obvious over and patentably

distinguishable from Gennaro et al. in view of Himmel et al. whereby the rejection under 35

U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's

rejections under 35 U.S.C. §§102 and 103 and places the present application in condition for

allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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